



RECEIVED
APR 29 2004
OFFICE OF PETITIONS

AKS

PATENT
Customer Number 22,852
Attorney Docket No. 09481.0004-01000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Laurette Nacamulli et al.)
Reissue Application No.: 09/099,048) Group Art Unit: 1641
Filed: June 17, 1998) Examiner: M. E. Ceperley
For: RATE MEASUREMENTS OF)
BIOMOLECULAR REACTIONS)
USING)
ELECTROCHEMILUMINESCENCE)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**PETITION TO SUSPEND THE RULES UNDER 37 C.F.R. §1.183
OR TO BE ACCORDED STATUS UNDER 37 C.F.R. § 1.47(a)**

Applicants hereby petition the Commissioner to suspend the rules regarding the requirement for the signature of all joint inventors on a supplemental Reissue Declaration and Power of Attorney.

United States Patent Application No. 08/347,984 (the "984 application"), now United States Patent No. 5,527,710 (the "710 patent"), was filed on December 2, 1994, naming Laurette Nacamulli, Jonathan K. Leland, and Stephanie Hayes as inventors. Each of the inventors assigned their rights to the '984 application to IGEN, Inc. ("IGEN"). The '710 patent issued on June 18, 1996.

On June 17, 1998, the above-identified reissue application was filed in order to broaden the scope of the claims in the '710 patent. The reissue declaration was filed on

June 17, 1998, and was signed by two of the three joint inventors of the '984 application, i.e., Jonathan K. Leland and Stephanie Hayes. A first Petition to Suspend the Rules Under 37 C.F.R. § 1.183 detailing the attempts of Barry Evans, IGEN's patent attorney at the time, to obtain the signature of the missing inventor, Laurette Nacamulli, was mailed to the U.S. Patent and Trademark Office (the "Office") on October 29, 1998. A copy of that document is attached to this Petition as Exhibit A. On September 28, 1999, the Office granted Applicants' first Petition and accorded Rule 1.47(a) status to this application.

In an *Ex parte Quayle* Action mailed October 28, 2003, the Examiner required a supplemental declaration in accordance with M.P.E.P. § 1415. On February 23, 2004 Ms. Tanya Sell of the BioVeris Corporation¹ sent a supplemental declaration to Ms. Laurette Nacamulli at her last known address. See Declaration of Tanya Sell (the "Sell Declaration"), ¶ 6. On February 26, 2004 the envelope containing the supplemental declaration was returned to Ms. Sell by the United States Postal Service. See *id.*, ¶ 7. Copies of the letter, the supplemental declaration, and the envelope showing the return to sender stamp are attached to the Sell Declaration.

35 U.S.C. § 116 dictates how the remaining inventors may pursue an application despite their inability to find or reach a joint inventor after diligent effort. It states, in pertinent part:

If a joint inventor ... cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the

¹ On February 12, 2004 IGEN assigned the '710 patent to the BioVeris Corporation. See Recordation of Assignment filed concurrently herewith.

inventor making the application subject to the same rights which the omitted inventor would have had if he had been joined.

By virtue of Mr. Evans' and Ms. Sell's attempts to reach Ms. Nacamulli to obtain her signature on the Reissue Declaration and Power of Attorney and the supplemental Reissue Declaration and Power of Attorney, Applicants submit that a diligent effort has been made to contact Ms. Nacamulli.

In view of the foregoing remarks and exhibits, it is respectfully submitted that Applicants have complied with 35 U.S.C. § 116 and 37 C.F.R. § 1.183. Therefore, Applicants request that the Commissioner suspend the rules in this instance and allow the Applicants to pursue the above-identified reissue application without the signature of Ms. Nacamulli on the supplemental Reissue Declaration and Power of Attorney.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 27, 2004

By: _____
William L. Strauss
Reg. No. 47,114



RECEIVED

APR 29 2004

OFFICE OF PETITIONS

PATENT
KM39091-70

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Nacamulli et al.
Serial No. : 09/099,048
Reissue of : U.S. Patent No. 5,527,710
Filed : June 17, 1998
For : RATE MEASUREMENTS OF BIOMOLECULAR
REACTANTS USING ELECTROCHEMILUMINESCENCE
Group Art Unit : 1641
Examiner : NOT YET ASSIGNED

200 Park Avenue
New York, New York 10166

I hereby certify that his correspondence
is being deposited with the United States
Postal Service as first class mail in an
envelope addressed to:
Assistant Commissioner for Patents
Washington, D.C. 20231, on October 29, 1998

Pamela C. Ancona, Reg. No. 41,494
Name of Applicant, Assignee or Registered
Representative

Pamela C. Ancona
Signature

October 29, 1998
Date of Signature

**PETITION TO SUSPEND THE RULES
UNDER 37 C.F.R. §1.183**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants hereby petition the Commissioner to suspend
the rules regarding the requirement for the signature of all
joint inventors on a Reissue Declaration and Power of Attorney.

PATENT
KM39091-70

Enclosed herewith is a check in the amount of \$130.00 to cover the petition fee set forth in 37 C.F.R. § 1.17.

U.S. Application Serial No. 08/347,984 (the "'984 application"), now U.S. Patent No. 5,527,710, was filed on December 2, 1994, naming Laurette Nacamulli, Jonathan K. Leland, and Stephanie Hayes as inventors. At the time of filing, each of the inventors were employees of IGEN, Inc. and they assigned their rights to the '984 application to IGEN, Inc. Subsequently, Laurette Nacamulli left her position at IGEN, Inc. and she provided no forwarding address. Shortly thereafter, the '984 application issued as U.S. Patent No. 5,527,710 (on June 18, 1996).

After issuance, the patent was reviewed and it was determined that the issued claims did not provide protection for the entire scope of the invention. Specifically, the patent claimed less than the inventors had a right to claim, such that the patent failed to claim a method for determining the time course of a reaction and method for determining the concentration of a reactant.

Thus, the above-identified reissue application was filed on June 17, 1998 in order to broaden the scope of the claims in U.S. Patent No. 5,527,710. The reissue declaration was filed on June 17, 1998 and was signed by two of the three joint

inventors of the '984 application, i.e., Jonathan K. Leland and
Stephanie Hayes.

On June 16, 1998, the undersigned attempted to contact Ms. Nacamulli to obtain her signature on the Reissue Declaration and Power of Attorney, using her last known address. A copy of that letter is enclosed as Exhibit A. When no response was received, a second letter was sent via registered mail on September 22, 1998 and a return receipt was requested. On September 24, 1998 the letter was returned to the undersigned, indicating on the envelope that the forwarding order expired, i.e. that Ms. Nacamulli no longer resided at that address and mail sent to that address was no longer being forwarded to her at her new address. Copies of the letter, return receipt, and envelope showing the return to sender stamp are enclosed as Exhibit B.

35 U.S.C. § 116 dictates how the remaining inventors may pursue an application despite their inability to find or reach a joint inventor after diligent effort. It states, in pertinent part:

If a joint inventor . . . cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the

application, subject to the same rights which the omitted inventor would have had if he had been joined.

By virtue of the undersigned's attempts to reach Ms. Nacamulli to obtain her signature on the Reissue Declaration and Power of Attorney, Applicants submit that a diligent effort has been made to contact Ms. Nacamulli.

Therefore, in view of the foregoing remarks and exhibits, it is respectfully submitted that Applicants have complied with 35 U.S.C. §§ 116 and 37 C.F.R. § 1.183. Therefore, Applicants request that the Commissioner suspend the rules in this instance and allow Applicants to pursue the above-identified reissue application without the signature of Ms. Nacamulli on the Reissue Declaration and Power of Attorney.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment resulting from this petition to Deposit Account No. 50-0297.

Respectfully submitted,

WHITMAN BREED ABBOTT & MORGAN, LLP
Attorneys for Applicants

By:


Barry Evans
Reg. No. 22,802
John E. Boyd
Reg. No. 38,055
Pamela C. Ancona
Reg. No. 41,494
(212) 351-3000

Exhibit 1

WHITMAN BREED ABBOTT & MORGAN LLP

LONDON
TOKYO

200 PARK AVENUE
NEW YORK, N.Y. 10166

212-351-3000

TELECOPIER: 212-351-3131

TELEX: RCA 236436

WRITER'S DIRECT NUMBER

(212) 351-3033

GREENWICH
NEWARK
LOS ANGELES
PALM BEACH

June 16, 1998

CONFIDENTIAL

VIA FEDERAL EXPRESS

Ms. Laurette Nacamulli
5202 Crossfield Ct., #15
Rockville, Maryland 20852

Re: Reissue Application For
U.S. Patent No. 5,527,710 by Nacamulli et al.
Our Ref. No. KM39091-70

Dear Ms. Nacamulli:

We represent IGEN, Inc. regarding the above-identified matter. As you may know, a patent application, of which you were a named inventor, issued as U.S. Patent No. 5,527,710 on June 18, 1996. A copy of U.S. Patent No. 5,527,710 is attached.

After issuance, the patent was reviewed and it was determined that the issued claims did not provide protection for the entire scope of the invention. Thus, we have been instructed to file the above-identified application to reissue U.S. Patent 5,527,710.

As stated above, the patent claimed less than the inventors had a right to claim. Specifically, the patented claims are insufficient in that they fail to claim the method for

WHITMAN BREED ABBOTT MORGAN LLP

Ms. Laurette Nacamulli

-2-

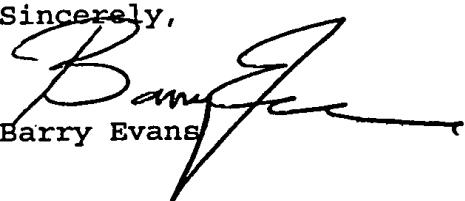
June 16, 1998

determining the time course of a reaction and method for determining concentration of a reactant set forth in the new proposed claims to be added in the reissue application (Attached). The new proposed claims do not recite steps (c) - (k) of patented claim 1 or limit the claims to a specific type of reaction.

Accordingly, we have enclosed an Inventor Declaration and Power of Attorney for your execution. The other named inventors, Jonathan K. Leland and Stephanie Hayes, will also execute copies of the Declaration. Please review the Declaration and enclosed documents and forward an executed Declaration to us at your earliest opportunity. We have enclosed a self-addressed envelope for your convenience.

If you have any questions or comments, please do not hesitate to contact us.

Sincerely,


Barry Evans

BE:JEB:kw
Enclosure

Exhibit 2

WHITMAN BREED ABBOTT & MORGAN LLP

LONDON
TOKYO

200 PARK AVENUE
NEW YORK, N.Y. 10166

212-351-3000

TELECOPIER: 212-351-3131

TELEX: RCA 238436

WRITER'S DIRECT NUMBER

(212) 351-3317

GREENWICH
NEWARK
LOS ANGELES
PALM BEACH

September 22, 1998

CONFIDENTIAL

VIA REGISTERED MAIL
(RETURN RECEIPT REQUESTED)

Ms. Laurette Nacamulli
5202 Crossfield Ct., #15
Rockville, Maryland 20852

Re: Reissue Application for U.S. Patent No.
5,527,710 to Nacamulli et al.
Our Ref. No.: KM39091-70

Dear Ms. Nacamulli:

On June 16, 1998 we requested that you execute an Inventor Declaration and Power of Attorney for the above-identified reissue application. A copy of that letter is enclosed. To date, we have not received your response to our request. Therefore, enclosed is a second Declaration and Power of Attorney for your signature.

As discussed in our June 16, 1998 letter, we have been instructed to file a reissue application for U.S. Patent No. 5,527,710 by our client, IGEN, Inc. The reissue application was filed because the issued claims do not provide protection for the entire scope of the invention.

As we have not received your response to our June 16, 1998 letter, enclosed is a second Declaration and Power of Attorney for your execution. The other named inventors, Jonathan K. Leland and Stephanie Hayes, have executed the Declaration. Please review the enclosed materials and forward the executed Declaration to us as soon as possible. We have enclosed a self-addressed envelope for your convenience.

WHITMAN BREED ABBOTT MORGAN LLP

Ms. Laurette Nacamulli

-2-

September 22, 1998

We look forward to receiving the executed Declaration.
If you have any questions, please do not hesitate to contact us.

Very truly yours,


Pamela C. Ancona, Ph.D.
Scientific Consultant

PCA:dmp
Encl.

WHITMAN BREED ABBOTT & MORGAN LLP

200 PARK AVENUE, NEW YORK, N.Y. 10166

RECEIVED SEP 27 1998

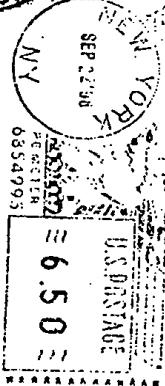
U.S. MAIL

NEW YORK

REG. MAIL

6.50

6854903

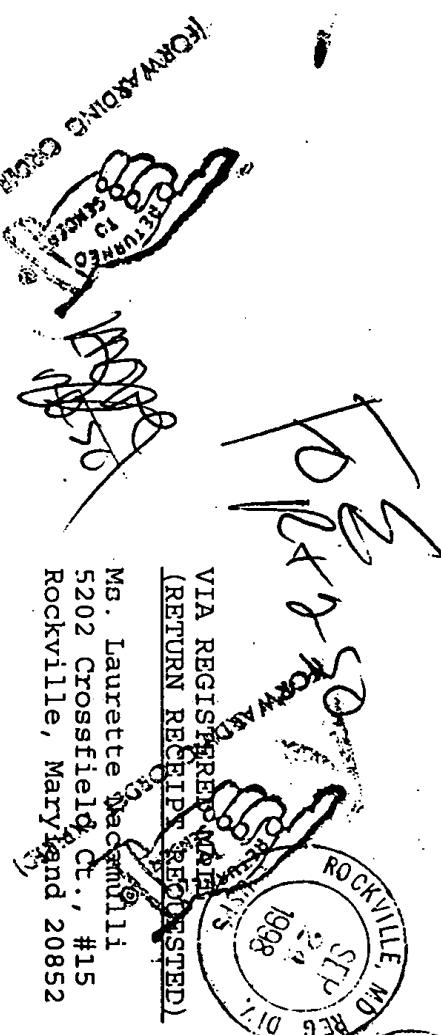


REGISTERED MAIL

R 790 934 389

VIA REGISTERED MAIL
(RETURN RECEIPT REQUESTED)

MS. Laurette Macmilli
5202 Crossfield Ct., #15
Rockville, Maryland 20852



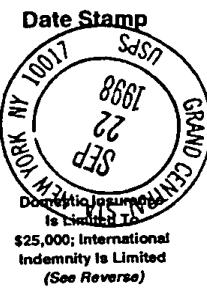
BEST AVAILABLE COPY

Registered No. *R 790934389*

To Be Completed By Customer By Post Office	Reg. Fee \$ <i>4.85</i>	Special Delivery
	Handling \$	Return \$ <i>1.10</i>
	Charge	Receipt
	Postage \$ <i>.55</i>	Restricted \$ Delivery
	Received by <i>10</i>	

Customer Must Declare
Full Value \$ *100*

With Postal
Insurance
 Without Postal
Insurance



FROM *Pamela C. Ancona, Ph.D.
Whitman Breed Abbott & Morgan LLP
200 Park Avenue*

TO *Ms. Laurette Nacamulli
5202 Crossfield Ct., #15
Rockville, Maryland 20852*

PS Form 3806, February 1995

Receipt for Registered Mail *(Customer Copy)*
(See Information on Reverse)

100-122 RETURN ADDRESS completed on the reverse side?

SENDER:

- Complete items 1 and/or 2 for additional services.
- Complete items 3, 4a, and 4b.
- Print your name and address on the reverse of this form so that we can return this card to you.
- Attach this form to the front of the mailpiece, or on the back if space does not permit.
- Write "Return Receipt Requested" on the mailpiece below the article number.
- The Return Receipt will show to whom the article was delivered and the date delivered.

I also wish to receive the following services (for an extra fee):

- Addressee's Address
- Restricted Delivery

Consult postmaster for fee.

3. Article Addressed to:

*Ms. Laurette Nacamulli
5202 Crossfield Ct., #15
Rockville, Maryland 20852*

4a. Article Number:

R 790934389

4b. Service Type

Registered Certified
 Express Mail Insured
 Return Receipt for Merchandise COD

7. Date of Delivery

5. Received By: (Print Name)

X

8. Addressee's Address (Only if requested and fee is paid)

6. Signature: (Addressee or Agent)

PS Form 3811, December 1994 *102595-97-B-0179* *Domestic Return R ceip*

BEST AVAILABLE COPY

PATENT
Customer Number 22,852
Attorney Docket No. 09481.0004-01000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Laurette Nacamulli et al.)
Serial No.: 09/099,048) Group Art Unit: 1641
Filed: June 17, 1998) Examiner: M. E. Ceperley
For: RATE MEASUREMENTS OF)
BIOMOLECULAR REACTIONS)
USING)
ELECTROCHEMILUMINESCENCE)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

DECLARATION OF TANYA SELL

I, Tanya Sell, do hereby make the following declaration:

1. I am a paralegal at BioVeris Corporation, the Assignee of this patent application.
2. BioVeris Corporation is responsible for prosecution of this patent application.
3. I am responsible for ensuring that the inventors execute the Oath or Declaration for U.S. patent applications.
4. The invention described in this application was made by Laurette Nacamulli, Jonathan K. Leland, and Stephanie A. Hayes.

PATENT
Attorney Docket No. 03715-0062

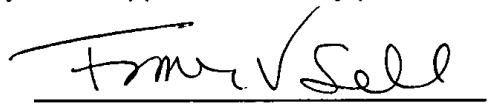
5. The last known address of Ms. Laurette Nacamulli is 5202 Crossfield Ct. #15, Rockville, Maryland 20852 U.S.A.

6. I forwarded a copy of the supplemental declaration with a cover letter, to Ms. Laurette Nacamulli at her last known address on February 23, 2004, for her execution. Copies of my letter and the supplemental declaration mailed to Ms. Nacamulli are attached as Exhibit 1 to this declaration.

7. The letter and supplemental declaration were returned to me by the United States Postal Service stamped "Attempted Not Known". A copy of the returned envelope showing the return to sender stamp is attached to this declaration as Exhibit 2.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements might jeopardize the validity of the application or any patent issuing thereon.

By:


Tanya V. Sell
BioVeris Corporation
16020 Industrial Drive
Gaithersburg, Maryland 20877
USA

Date: 4/22/04



February 23, 2004

Laurette Nacamulli
5202 Crossfield Ct., #15
Rockville, Maryland 20852

Stephanie A. Jameison
18810 Walker's Choice #4
Gaithersburg, Maryland 20879

Re: US Application No. 09/099,048
Filed: June 17, 1998
Titled: Rate Measurements of Biomolecular Reactant's Using
Electrochemiluminescence

Dear Named Inventor:

As a named inventor on the above mentioned issued patent, it is necessary for your review and signature on the enclosed Supplemental Declaration for Reissue. The Declaration is to correct errors in that were undetected in the issued patent 5,527,710.

Once signed, please return them to me in the self-addressed, postage paid envelope enclosed.

Please call 301-869-9800, 2037 with any questions.

Sincerely,

A handwritten signature in black ink that reads "Tanya V. Sell".

Tanya V. Sell

Enclosures

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Nacamulli et al.
Serial No. : 09/099,048
Reissue of: : U.S. Patent No. 5,527,710
Filed : June 17, 1998
For : **RATE MEASUREMENTS OF BIOMOLECULAR
REACTANTS USING ELECTROCHEMILUMINESCENCE**
Group Art Unit : 1641
Examiner : M. E. Ceperley

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

CERTIFICATE OF FIRST CLASS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on _____, 2004.

Mary W. Richardson, Registration No. 48,320
Kramer Levin Naftalis & Frankel LLP

**SUPPLEMENTAL DECLARATION FOR REISSUE PATENT APPLICATION
TO CORRECT "ERRORS" STATEMENT (37 CFR 1.175)**

Sir:

I, a below named inventor, hereby declare that:

My citizenship, residence and Post Office Address are as stated below next to my name.

Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior declaration submitted in this application, arose without any deceptive intention on the part of the applicant.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are

punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

INVENTOR (S):

Signature: _____ Date: _____

Full name of first inventor: Laurette Nacamulli
Residence: 5202 Crossfiled Ct., #15
Rockville, Maryland 20852

Citizenship: Greece

Signature: Jonathan K. Leland Date: 1-9-03

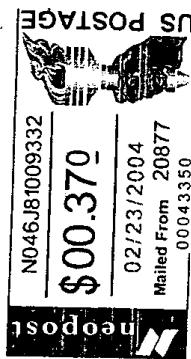
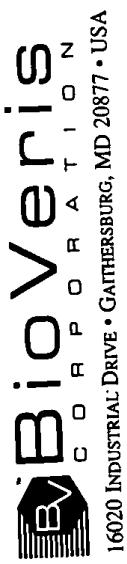
Full name of second inventor: Jonathan K. Leland
Residence: 14236 Amberleigh Terrace
Silver Springs, Maryland 20905

Citizenship: USA

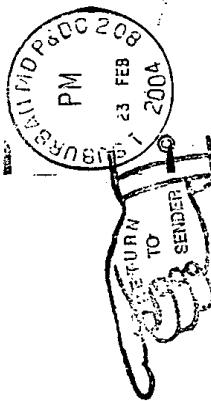
Signature: _____ Date: _____

Full name of third inventor: Stephanie A. Hayes
Residence: 18810 Walker's Choice, #4
Gaithersburg, Maryland 20879

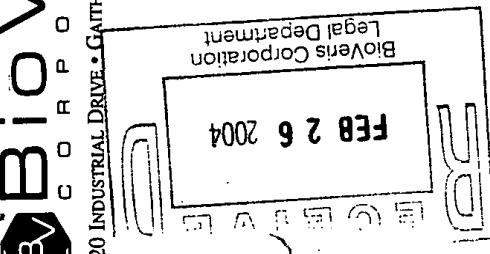
Citizenship: USA



Tanya V. Sell
BioVeris Corporation
16020 Industrial Drive
Gaithersburg, MD 20877



Bioveris
C O R P O R A T I O N
16020 INDUSTRIAL DRIVE, GATHERSBURG, MD 20877 • USA



BEST AVAILABLE COPY